## REMARKS

This Amendment is submitted in response to the non-final Office Action mailed on August 8, 2008. A petition for a one month extension of time is submitted herewith. The Director is authorized to charge $130.00 for the petition for the one month extension of time and any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112701-568 on the account statement.

Claims 1-8 and 10-20 are pending in this application. Claim 9 was previously canceled without prejudice or disclaimer. In the Office Action, Claims 1-8 and 10-20 are rejected under 35 U.S.C. §103. Applicants believe these rejections are improper and respectfully traverse them for at least the reasons set forth below.

In the Office Action, Claims 1-8 and 10-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over GB 2027662 to Marek ("*Marek*") in view of U.S. Patent No. 6,455,093 to Furrer et al. ("*Furrer*"). Claims 17-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Marek* and *Furrer* in further view of U.S. Patent No. 6,777,007 to Cai ("*Cai*"). However, Applicants respectfully submit that the cited references are deficient with respect to the present claims.

Currently amended independent Claim 1 recites, in part, a beverage portioned package for preparing a beverage in an extraction device, wherein the package contains a water-soluble beverage material in an amount sufficient to form the beverage and a filler; with the filler comprising a water insoluble material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material, wherein the ratio of water-soluble material to filler is between 1:1 and 1:8 by volume. Currently amended independent Claim 20 recites, in part, a method of making a foamed beverage from a soluble beverage-forming material, the method comprising providing the package with a water-soluble beverage material in an amount sufficient to form the beverage and a filler therein, and forming a pressure resistant bed in the filler in the packaging, the filler comprising a water insoluble material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at

a pressure above that which is created by the sole resistance of the package to facilitate formation of a foam on the beverage that is dispensed from the extraction device. The amendments do not add new matter. The amendments are supported in the Specification at, for example, page 6, line 30-page 7, line 1.

The water-soluble beverage material of the present invention provides the primary beverage ingredient for the beverage which is delivered through an extraction device. See, Specification, page 6, lines 30-33. The portion of water-soluble beverage material is intended to thoroughly mix with water during the extraction. See, Specification, page 7, lines 1-2. The water-soluble beverage material includes, for example, soluble coffee powder, milk powder, creamer powder, cocoa powder and mixtures thereof. See, Specification, page 7, lines 6-7. The filler maintains a sufficient pressure of extraction while the water-soluble beverage material dissolves in the water passing through the package to release the beverage. See, Specification, page 2, lines 25-28. The filler is configured to decrease the pressure drop during extraction to less than 0.2 bars. See, Specification, page 3, lines 3-6. Maintaining the pressure during extraction ensures that the beverage delivers the desired solids concentration and that a sufficient amount of foam is created. See, Specification, page 2, lines 29-31. A beverage package including such filler thus provides significantly improved properties over beverage packages that do not contain such a filler. See, Specification, page 2, lines 31-32. In view of the amendments and for the reasons set forth below, Applicants respectfully submit that the cited references fail to disclose or suggest every element of the present claims.

*Marek* fails to disclose or suggest a beverage portioned package for preparing a beverage in an extraction device, wherein the package contains a water-soluble beverage material as required, in part, by the present claims. *Marek* also fails to disclose or suggest a beverage portioned package for preparing a beverage in an extraction device, wherein the ratio of water-soluble material to filler is between 1:1 and 1:8 by volume as required, in part, by the present claims. Further, *Marek* also fails to disclose or suggest a package having a filler comprising a water insoluble material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the package as required, in part, by the present claims.

Instead, *Marek* is entirely directed to a filter bag for coffee preparation that contains ground coffee or coffee mixtures in ground form. See, *Marek*, page 1, lines 22-25 and 45-54. *Marek* specifically states that "[t]he term coffee used herein means conventional roasted coffee or corresponding coffee mixtures in ground form." See, *Marek*, page 1, lines 55-57. Thus, the ground coffee and ground coffee mixtures of *Marek* are water-insoluble materials. Unlike the water-insoluble ground coffee disclosed in *Marek*, the present claims are directed to a water-soluble beverage material such as soluble coffee powder, milk powder, creamer powder, cocoa powder and mixtures thereof. See, Specification, page 7, lines 6-7. Indeed, the Specification states that the filler may be any water-insoluble material and includes cellulose, fiber, fresh ground coffee or spent ground coffee. See, Specification, page 7, lines 19-20 and 28-29. Therefore, *Marek* fails to disclose a beverage portioned package for preparing a beverage in an extraction device, wherein the package contains a water-soluble beverage material in accordance with the present claims.

With respect to the presently claimed ratio of water-soluble material to filler, the only disclosure of the quantity of filler in *Marek* states that the amount of neutral anti-agglomerating materials "range[s] generally from approximately 0.1 to 100%, preferably from 1 to 50%, relative to the coffee." See, *Marek*, page 1, lines 91-95. However, even if the ratio of "neutral anti-agglomerating materials" are present in *Marek* in an amount of 1:1, neither the ground coffee nor the "neutral anti-agglomerating materials" are water-soluble as discussed above and, as such, *Marek* still fails to disclose or suggest a beverage portioned package for preparing a beverage in an extraction device, wherein the ratio of water-soluble material to filler is between 1:1 and 1:8 by volume as required, in part, by the present claims.

For example, *Marek* states that the term "coffee" as used in *Marek* also refers to coffee "which may be replaced wholly or partly b[y] coffee substitutes or contain coffee additives." See, *Marek*, page 1, lines 57-62. Coffee substitutes include roasted barley grains and chicory and may be in finely powdered/soluble form, ground form or left whole. See, Wikipedia Online Encyclopedia, http://en.wikipedia.org/wiki/Coffee_substitute. If the coffee substitutes are all in ground form, such substitutes are insoluble in water. Thus, contrary to the Patent Office's assertion, the mere disclosure of coffee substitutes does not necessarily disclose water-soluble beverage materials.

Even if the coffee of *Marek* consists entirely of coffee substitutes, such substitutes are not water-soluble materials. In fact, the Patent Office even admits that "*Marek* is silent with respect to the ground coffee and/or the coffee substitutes being a soluble material." See, Office Action, page 3, lines 25-26. *Marek* specifically states that the term "coffee" means "roasted coffee or coffee mixtures in ground form. However, this term also refers to coffee. . . which may be replaced wholly or partly by coffee substitutes." See, *Marek*, page 1, lines 55-62 (emphasis added). Even if the "coffee" is replaced by coffee substitutes, the limitation of "in ground form" may be read to apply to such substitutes.

Furthermore, the filter bags of *Marek* contain one or more neutral anti-agglomerating materials "which prevent the coffee from agglomerating during brewing." See, *Marek*, page 1, lines 45-50 and 68-70. Such anti-agglomerating materials reduce or prevent agglomeration of the coffee by keeping the grains physically separate or loose. See, *Marek*, page 1, lines 70-74. Since *Marek* does not limit or eliminate the use of anti-agglomerating materials when coffee substitutes are used, such coffee substitutes must also contain grains that have a tendency to agglomerate and are insoluble in water. In fact, *Marek* even discloses that the "neutral anti-agglomerating materials" are "used in particulate form and are preferably water-insoluble, inorganic compounds of neutral flavor . . . that can be used directly in powder or ground form." See, *Marek*, page 1, lines 68-89. Therefore, *Marek* fails to disclose or suggest a beverage portioned package for preparing a beverage in an extraction device, wherein the ratio of water-soluble material to filler is between 1:1 and 1:8 by volume as required, in part, by the present claims.

Regarding the current amendment, which requires that the filler comprises a water insoluble material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the package, it is clear that *Marek* fails to disclose or suggest this claimed element since *Marek* fails to disclose or suggest any water-soluble beverage material. The Patent Office even admits that *Marek* fails to disclose or suggest same. Specifically, the Patent Office clearly states that "*Marek* is silent with respect to the ground coffee and/or the coffee substitutes being a soluble material." See, Office Action, page 3, lines 25-26. Accordingly, Applicants respectfully submit that the Patent Office's assertion that *Marek* "inherently" teaches forming a

pressure resistance bed that maintains extraction pressure is now rendered moot. Indeed, since the Patent Office has admitted the lack of any disclosure or suggestion of the water-soluble beverage material of the present claims, Applicants respectfully submit that the Patent Office's assertion that *Marek* "inherently" discloses this feature can no longer hold true in view of the current amendments.

Further, the filler disclosed in *Marek* is adapted to decrease the pressure in the coffee bags. For example, the purpose of the filler is to prevent or reduce agglomeration of the coffee by keeping the grains physically separate or loose. See, *Marek*, page 1, lines 70-78. However, breaking up the grains and keeping them loose acts to decrease the pressure, rather than maintain the pressure. Thus, *Marek* teaches the use of a filler to create a lower pressure than that of the beverage package or coffee alone. As such, *Marek* fails to disclose or suggest a filler comprising a water insoluble material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the package as required, in part, by the present claims.

*Furrer* fails to disclose or suggest fails to disclose or suggest a beverage portioned package for preparing a beverage in an extraction device, wherein the ratio of water-soluble material to filler is between 1:1 and 1:8 by volume as required, in part, by the present claims. Further, *Furrer* also fails to disclose or suggest a package having a filler comprising a water insoluble material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the package as required, in part, by the present claims.

Instead, *Furrer* is entirely directed toward a process for the recovery of aroma components from coffee grounds. See, *Furrer*, Abstract. However, Applicants respectfully submit that ground coffee is the basic material used to produce all coffee products. At the end of the process of *Furrer*, and in direct contrast to the presently claimed subject matter, there exists only a powder of soluble coffee extract that is not in contact with any ground coffee. In fact, the examples of *Furrer* teach obtaining aroma components from fresh coffee grounds by wetting coffee grounds, heating the coffee grounds, exposing the coffee grounds to decreased pressure for providing aroma containing gas, and capturing the aroma gas. The aroma gas is then condensed, collected and freeze dried to create a powder. The powder alone is then "dissolved"

in hot water and is found to have "good coffeeness." See, *Furrer*, Examples 1-4. Accordingly, *Furrer* does not even contemplate the use of both a water insoluble material and a water soluble filler simultaneously to product a coffee beverage. Accordingly, *Furrer* fails to disclose or even suggest either a beverage portioned package for preparing a beverage in an extraction device, wherein the ratio of water-soluble material to filler is between 1:1 and 1:8 by volume or a package having a filler comprising a water insoluble material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the package as required, in part, by the present claims.

Similarly, *Cai* fails to disclose or suggest a filler comprising a water insoluble material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the package. The Patent Office relies on *Cai* merely for the disclosure of brewing soluble substances under pressure and using a "pod" arrangement to produce an infused beverage. Nowhere does *Cai* disclose a filler adapted to maintain extraction pressure above that which is created by the package alone, nor does the Patent Office cite support for such limitation. Therefore, the cited references fail to disclose or suggest a filler comprising a water insoluble material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the package as required, in part, by the present claims.

With respect to Claims 17-19, as discussed previously, *Marek* and *Furrer* fail to disclose or suggest every element of independent Claim 1 from which Claims 17-19 depend. The Patent Office relies on *Cai* only for the disclosure of a filter pod and brewing soluble substances under pressure; the Patent Office relies on *Marek* and *Furrer* for the specific ingredients of the beverage package. Therefore, Applicants respectfully submit that *Cai* fails to remedy the deficiencies of *Marek* with respect to Claims 17-19. Accordingly, Applicants respectfully submit that *Marek*, *Furrer* and *Cai* fail to disclose each and every element of the present claims.

Applicants also respectfully submit that the skilled artisan would have no reason to combine *Marek* with *Furrer* to arrive at the present claims. Specifically, Applicants maintain that the Patent Office continues to misconstrue the disclosure of *Marek*. For example, *Marek*

states that it was known in the art to prepare coffee either by filtering ground coffee or dissolving coffee extracts. On one hand, coffee extracts are easy to use but they provide inferior quality coffee drinks when compared to drinks prepared using ground coffee. On the other hand, coffee drinks prepared using ground coffee require specific and complicated equipment wherein the machine or a filter container must be cleaned after use. The aim of *Marek*, then, is to use the advantages of both methods – to keep ground coffee as the starting material to have better quality but to use a method that does not require specific and complicated equipment. See, *Marek*, page 1, lines 8-44.

*Marek* teaches filling bags with coffee grounds similar to known tea bags. However, with this scenario, the problem of agglomeration arises. To solve this problem, *Marek* proposes mixing the coffee grounds with a filler in the bag. *Marek* focuses on ground coffee because the problem of agglomeration only arises with non-soluble particles. Thus, *Marek* offers no suggestion or reason why placing soluble components in the bag would offer any benefit. *Furrer* fails to remedy the deficiencies of *Marek* because *Furrer* is entirely directed toward a process for producing soluble coffee that is dissolved in hot water to make instant coffee. As discussed above, this process starts from roasted and ground coffee, which is the basic material to produce all coffee products, but at the end of the process, the produced composition includes only a soluble coffee powder and no ground coffee. Accordingly, the skilled artisan would have no reason to combine *Marek* and *Furrer* to arrive at the present claims.

Applicants also respectfully submit that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Accordingly, references are not properly combinable or modifiable if their intended purpose is destroyed. This certainly applies here, where *Furrer* is entirely directed toward a soluble powder that is intended to be used as an instant coffee and where *Marek* is entirely directed toward the use of insoluble particulate material in ground form and makes no references to the use of water-soluble components.

In response to the Patent Office's assertion that Applicants have addressed the references individually and not as a combination of references, Applicants respectfully submit that, to the extent that the references are discussed individually, it is not to address the rejections as anticipation rejections, but rather to point out the deficiencies of the cited references. In this case, not only would the skilled artisan lack any reason to combine the cited references, but the cited references also fail to disclose each and every element of the present claims.

Accordingly, Applicant respectfully requests that the obviousness rejection with respect to Claims 1-8 and 10-20 be reconsidered and the rejection be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same. In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Respectfully submitted,

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